

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-10 are rejected under 35 USC 102(b) as being anticipated by the U.S. patent to Zagorski.

Also, the drawings and Claim 1 are objected to and the claims are rejected under 35 USC 112.

In connection with the Examiner's formal objections and rejections, applicants submitted an additional drawing showing a width dimension and a rotation direction as required by the Examiner, and amended the claims correspondingly.

It is therefore believed that the grounds for the Examiner's formal objections and rejections should be considered as no longer tenable and should be withdrawn.

In connection with the Examiner's rejection of the claims over the art, it is believed to be advisable to analyze first of all Claim 1, the broadest claim on file, and to emphasize the new features of the present invention which are defined in it.

Claim 1 defines a connecting device which has at least one connecting element for connecting a motor housing (2) to a transmission housing (3), and which has an axial dimension in a direction (X) of an axis (25) of a motor shaft (6), a radial dimension in a direction (Z) perpendicular to the axis (25) of the motor shaft (6), and a width dimension in a predetermined direction (Y) which is perpendicular to the axial dimension and to the radial dimension, and wherein the width dimension of the connecting element is smaller than its axial dimension and is radial dimension; and also the connecting element is at least partially elastically deformable when the motor housing (2) moves relative to the transmission housing (3) in a rotating fashion around the axis (25) of the motor shaft (6).

Turning now to the reference applied by the Examiner, and in particular to the patent to Zagorski, it can be seen that this reference discloses an electric motor with permanent magnet stator poles and a method of making the same. In the device disclosed in this reference, the element (16), contrary to the connecting element of the applicant's invention, is not elastically deformable in a width direction, since in this device the width dimension in the direction (Y) which is perpendicular to the axial dimension and the radial dimension is significantly longer than the radial dimension of the element (16). This can be clearly seen in Figure 2.

It is therefore undoubtedly clear that the connecting element of the connecting device in accordance with the present invention, and in particular its new features which have been emphasized hereinabove, is not disclosed in the patent to Zagorski, in which, because of lacking features of Claim 1 of the present invention, the element (16) does not represent an elastic coupling in the width direction which is perpendicular to the axial dimension and the radial dimension of the element identified relative to the axis of rotation of the motor shaft.

The original claims were rejected over the patent to Zagorski as being anticipated under 35 USC 102(b). In connection with this, it is believed to be advisable to cite the decision *In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Zagorski does not disclose each and every element of the present invention which are now defined in amended Claim 1.

Therefore, it is respectfully submitted that an anticipation rejection applied by the Examiner should be considered as not tenable and should be withdrawn.

The present invention as defined in amended Claim 1 also cannot be considered as obvious from the teaching of this reference. The reference does not contact any hint or suggestion for above mentioned new features of the present invention as defined in amended Claim 1. In order to arrive at the present invention from the teaching of the reference, the device disclosed in the reference has to be fundamentally modified, and in particular by including into it the new features of the present invention which are now defined in amended Claim 1. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision In Re Randol and Redford (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that Claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


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